

Application No. 10/615,794
Amendment dated December 13, 2005
Reply to Office Action of September 13, 2005

Docket No.: 20140-00302-US
Page 5 of 7

REMARKS

Status of Claims:

Claims 1-24 were pending in the application; claims 5 and 6 are hereby cancelled without prejudice or disclaimer of subject matter contained within. Claims 1-4 and 7-24 are now pending. Each of the pending claims defines an invention that is novel and unobvious over the cited art. Favorable consideration of this case is respectfully requested.

Rejection Under 35 U.S.C. § 102(b):

Claims 1-5 and 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by Seita (6,881,319).

Rejection under 35 U.S.C. § 102 requires the prior art disclose each and every recitation of the claimed invention.¹ In determining anticipation, no claim recitation may be ignored.² Anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims.³ There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. § 102.⁴ Claim 1 is hereby amended to further clarify at least one distinction over the cited art. The evidentiary record fails to teach each recitation of the present invention, as amended, in view of the silence of Seita regarding determining a threshold concentration of a void-formation marker (VFM).

As the Examiner states, Seita determines the concentration of an accelerator by-product which may be equivalent to the VFM of the present invention. Seita maintains the by-product concentration below a pre-determined value (column 5, lines 56-67). The pre-determined value of Seita relates to plating without "frosting" (line 60) and/or keeping a gloss finish (lines 61-2).

¹ See MPEP § 706.02.

² See *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990).

³ See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

⁴ See *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

Application No. 10/615,794
Amendment dated December 13, 2005
Reply to Office Action of September 13, 2005

Docket No.: 20140-00302-US
Page 6 of 7

The values of Seita do not relate to void-formation. Moreover, Seita does not teach the determination of a threshold concentration of a void-formation marker (VFM).

Rejections Under 35 U.S.C. § 103(a):

Claim 6 was rejected under 35 U.S.C. § 103(a) as being obvious in view of Seita together with Skoog (*Fundamentals of Analytical Chemistry*).

Claims 7-8 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Seita together with Talasek (US 2004/0108213).

Claims 12-14 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Seita together with Kopp (6,083,374).

To establish *prima facie* obviousness of a claimed invention, all the claim recitations must be taught or suggested by the prior art. *In re Royka*.⁵ All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*.⁶ (MPEP § 2143.03). When evaluating the scope of a claim, every recitation in the claim must be considered. See e.g. *In re Ochiai*.⁷ (MPEP § 2144.08). The evidentiary record fails to teach each recitation of the present invention as amended. Specifically, the references taken as a whole or severally fail to teach the determination of a threshold concentration of a void-formation marker (VFM).

The failings of Seita have been discussed above in connection with the rejection under § 102. Skoog merely teaches ion-pairing, a method of analytical chromatography, but does not supply the necessary teaching because Skoog does not relate to determination of a threshold value of a VFM for a plating bath. Talasek teaches that plating-bath by-products may be measured by spectroscopy or electrochemical methods. However, Talasek does not teach measurement of a voiding threshold concentration. Kopp does not complete Seita because Kopp teaches a bleed and feed method, but is silent as to determining a voiding threshold concentration.

⁵ *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

⁶ *In re Wilson*, 424 F.2d 1382, 165 USPQ 496 (CCPA 1970).

⁷ *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995).

Application No. 10/615,794
Amendment dated December 13, 2005
Reply to Office Action of September 13, 2005

Docket No.: 20140-00302-US
Page 7 of 7

Claims 10-11 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Chalyt (6,749,739) together with Blachier (6,569,307).

Chalyt relates to analysis of suppressor breakdown products, whereas the application relates to analysis of accelerator breakdown products. In particular, the present invention relates to the analysis of sulfur-containing species. Chalyt relates to the breakdown of high molecular weight polyethylene and polypropylene glycols.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0510, under Order No. 20140-00302-US from which the undersigned is authorized to draw.

Dated: December 13, 2005

Respectfully submitted,

By 

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